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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/462,376	03/07/2000	JULIEN M. SIGNES	9320.93USWO	5013

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EXAMINER

SANTIAGO, ENRIQUE L

ART UNIT	PAPER NUMBER
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2671

DATE MAILED: 06/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/462,376

Applicant(s)

SIGNES, JULIEN M.

Examiner

Enrique L. Santiago

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

The drawings are objected to because a foreign language is used in the figures. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities:

Examination of this application reveals that the disclosure includes terminology inconsistent from that which is generally accepted in the art to which this invention pertains. For example, the following underlined terms are not understood: On page 2, lines 1-10 “ the field of the invention is that of the restitution of animated graphic scenes, for example, on a multi-media terminal. More precisely, the invention relates to the modification of animated scenes, that is to say, the carrying out of point changes, remotely commanded, for example, by a remote server, of a graphic scene restituted on a terminal”.

The following definition of the underlined term may be found in the Cambridge International Dictionary of English:

Restitution- the return of items stolen or lost, or law payment made for damage or loss.

Applicant is required to submit an amendment that clarifies these matters using terms such as: replace, modify, update, manipulate, overlay or other art-accepted terminology. Applicant should be careful not to introduce any new matter into the disclosure (i.e., matter which is not supported by the disclosure as originally filed). Appropriate correction is required.

Abstract

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract is objected because it is not in narrative form (see lines 8-11), includes phraseology used in patent claims, such as "means" (see lines 2 and 12), "said" (see lines 4, 12 and 13), and is not limited to a single paragraph (see lines 13-15). Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are generally narrative and indefinite, failing to conform with current

U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

-Claim 1, on lines 1-2, recites the limitation "at least one graphic object, defined by at least on field" it is unclear if the object is defined by the field or if the field is defined by the object. On lines 4-5, claim 1, recites the limitation "means of constructing an image to show said graphic scene on at least one screen, intended for image construction means that can be shown on at least one screen" it is unclear if the image or the image construction means will be shown on the screen. Appropriate correction is required.

-Claims 2-6 are rejected due to their dependence on a rejected base claim.

-Claim 7, on lines 1-2, recites the limitation "Method of transmission of data for updating a graphic scene intended to be shown on at least one screen" it is unclear if the method of transmission of data or the updated graphic scene will be shown on the screen. Appropriate correction is required.

-Regarding claim 8, the word "means" is preceded by the words "characterized in that it comprises" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the words preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). The term "restitution" in claim 8 is used by the claim to mean "restore

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or update" while the accepted meaning is " Restitution- the return of items stolen or lost, or law payment made for damage or loss."

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 1-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1 and 7 recite method claims. The claims state a series of steps used to manipulate a model (object). The steps include; "frames for updating the graphic scene...including a command for replacement of the existing graphic scene..." Applicant has recited steps that do nothing more than manipulate basic mathematical constructs, hence the claim is unpatentable. See *In re Warmerdam*, 33 F.3d 1354, 1360 (Fed. Cir 1994). Patentable subject matter is held to exclude "laws of nature, natural phenomena, and abstract ideas". *Diamond v. Diehr*, 450 U.S. 175, 185, 101 S.Ct 1048, 1056 (1981). Applicant's method claims start with a step of manipulating an abstract idea (scene) and proceeds to generate another abstract idea (updated scene). Only an Applicant's claims are entitled to the protection of the patent system, therefore claims, if expressing ideas in a mathematical form, must describe something beyond the manipulation of ideas in order to qualify as patentable subject matter. *In re Warmerdam*, at 1360. Given the absence of any practical effect or significant independent physical acts, Applicant's claim fails to adequately define the claimed invention within the domain of patentable subject matter.

Claims 2-6 are similarly rejected as claim 1. Each of these claims provides further refinements of the method, but none of the claims include any limitations that provide some practical effect of the method, which would avoid a rejection for lack of statutory subject matter.

Claim 8 recites an apparatus claim. The claim indicates that “means” perform the steps of “up-dating said scene” Applicant has recited functions associated with means that do nothing more than manipulate basic mathematical constructs. Claiming an unpatentable process as a machine does not render patentable otherwise unpatentable subject matter.

The form of a claim does not control whether subject matter is statutory. *In re Maucorps*, 609 F.2d 481, 485, 203 USPQ 812, 815 (CCPA 1979). “Though a claim expressed in ‘means for’ functional terms is said to be an apparatus claim, the subject matter as a whole of that claim may be indistinguishable from that of a method claim drawn to the steps performed by the ‘mean.’” *In re Freeman*, 573 F.2d 1237, 1247, 197 USPQ, 464, 472(CCPA 1978). Functionally-defined means broadly drawn so as to “encompass any and every means for performing the recited functions” require that the Applicant meet the burden of demonstrating that the claims are drawn to special purpose apparatus, otherwise the claim will be treated as if drawn to the method which encompasses the claimed means. *In re Walter*, 618 F.2d 758, 768, 205 USPQ 397, 408(CCPA 1980).

Applicant recites no special purpose hardware to perform the functions associated with the means of claim 8. Since Applicant appears to propose, at best, that a general purpose computer would perform these functions, claim 8 fails to provide adequate definition of the apparatus to allow consideration of the means apart from their functions. Claim 8 is therefore rejected as drawn to nonstatutory subject matter.

Applicant may be able to overcome Examiner's rejections by amending the claims to encompass statutory subject matter. If Applicant were to include language in the claims which indicates some practical effect of the performance of the method or the operation of the apparatus, such as displaying the converted model, or some other significant independent physical acts, the Examiner believes, at this time, such an amendment would overcome the 101 rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Maystrovsky et al. US patent no. 5,850,535.

-Regarding claim 1, Maystrovsky et al. teaches a method for modifying a graphic scene (see the abstract, figs. 7-9, column 1, line 65-column 2, line 28), including commands for

updating said graphic scene (see column 2, lines 51-55), and replacing the graphic scene with the updated graphic scene (see the abstract, figs. 7-9, column 1, line 65-column 2, line 28).

-Regarding claims 2-5, Maystrovsky et al. further teaches a method including at least one of the following commands; insertion of an element, modification of an element, deletion of an element, replacement of and existing object by a new object (see the abstract, figs 2-4, and 7-9, column 5, line 39-column 6, line 12, column 7, lines 30-64).

-Regarding claim 6, Maystrovsky et al. further teaches a method including at least one of the following commands; insertion of an element, modification of an element, deletion of an element, replacement of and existing object by a new object (see the abstract, figs 2-4, and 7-9, column 5, line 39-column 6, line 12, column 7, lines 30-64), and the type of elements concerned according to the type of command (see figs 7-9, column 7, line 30-column 8, line 67), and defining the elements concerned (see figs 2-5 and 7-9, column 2, lines 29-50).

-Regarding claims 7 and 8, said claims combine the limitations of claims 1 and 2, therefore they are rejected for the same reasons.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US patent no. 6,166,744

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Enrique L. Santiago whose telephone number is (703) 306-5908. The examiner can normally be reached on Monday to Friday from 7:00 A.M. to 3:30 P.M..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Zimmerman, can be reached at (703) 305-9798.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

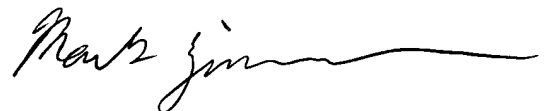
(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Enrique L. Santiago

May 31, 2002



MARK ZIMMERMAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600